

REMARKS

Claims 1-24 are pending in this application and were rejected in Paper No. 1. By this Amendment, claims 1 and 13 have been revised to emphasize the patentable features of the present invention. The amendments to the claims are fully supported by the specification and the original claims. No new matter has been added. Claims 1-24 will remain pending in this application. The Examiner is respectfully requested to reconsider and withdraw the outstanding rejections set forth in the Office Action in view of the remarks contained herein.

Claim Rejections – 35 U.S.C. § 112

Claims 13-24 were rejected under 35 U.S.C. § 112 as allegedly indefinite.

Applicants have carefully considered the rejection set forth in the Office Action. According to the Office Action, the recitation of “a first product” and “a second product” is unclear. In addition, the Examiner states that it is unclear where the chloride and silanes are removed as the overhead or bottom products from the distillation process. Applicants respectfully submit those skilled in the art would understand the meaning of the claims, as written, based on the disclosure in the specification (for example, see page 5 of the specification). The specification clearly describes the first and second products and outlines the procedure for removal of chloride and silanes. Therefore, Applicants request that the rejection be withdrawn because Applicants are not broadening the scope of the claim, rather they are narrowing the claim by identifying additional steps of the claimed method.

Claim Rejections – 35 U.S.C. § 103

Claims 1-24 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Seiler

(US 4,224,233), Schilling (US 6,015,920) or Bade (US 6,242,630). These references are cited as disclosing the reaction of an allyl compound with silane in the presence of a heterogeneous platinum catalyst.

With regard to the Bade reference, Applicants respectfully submit that this rejection is traversed under §103(c). Applicant submit that this reference only qualifies as prior art under §102(e). The Bade patent is assigned to Degussa AG. Therefore, Applicants can establish that, at the time the invention claimed in this application was made, both the claimed invention and Bade (US 6,242,630) were commonly owned by, or subject to an obligation of assignment to Degussa AG. Thus, the 103(a) rejection is subject to traversal under 103(c). As such, Applicant respectfully requests withdrawal of this rejection.

With regard to the Seiler and Schilling references, Applicants respectfully submit that independent claims 1 and 13, as amended, are not obvious in view of Seiler or Schilling.

The cited prior art patents generally disclose a reaction of an allyl compound with silane in the presence of a heterogeneous platinum catalyst. However, Applicants avow that the cited prior art fails to depict the following features of independent claims 1 and 13: (1) a reaction column, (2) a silane excess, and (3) the claimed temperature range along the reaction column.

Thus, Applicants assert that Seiler and/or Schilling would not have made it obvious to those of skill in the art to use the claimed method. The claimed method allows the preparation of propyl silanes with an unexpected lower content of by-products and high yield, as discussed on page 10 and shown by the Tables in the specification. Hence, Applicants respectfully submit that instant claims 1-24 would not have been obvious over Seiler and/or Schilling.

Applicants request the obviousness rejection be withdrawn.

CONCLUSION

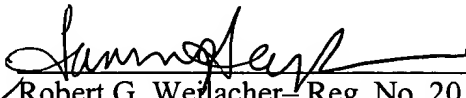
Applicant respectfully submits that the above remarks obviate the outstanding rejections in this case, thereby placing the application in condition for immediate allowance. Allowance of this application is earnestly solicited.

If any fees under 37 C.F.R. § 1.16 and 1.17 are due in connection with this filing, please charge the fees to Deposit Account No. 02-4300, Order No. 032301WC104.

Respectfully submitted,

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Signature:

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